SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, ~~1964~~ 1965

No. ~~530~~ //

WILLIAM T. GRAHAM, ET AL., PETITIONERS,

vs.

JOHN DEERE COMPANY OF KANSAS CITY, ET AL.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

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[fol. 923]

IN THE UNITED STATES COURT OF APPEALS

FOR THE EIGHTH CIRCUIT

No. 17,441

JOHN DEERE COMPANY OF KANSAS CITY, a Corporation, and DEERE & COMPANY, a Corporation, Appellants,

v.

WILLIAM T. GRAHAM, and GRAHAM PLOW, INC., Appellees.

Appeal from the United States District Court for the Western District of Missouri

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OPINION—June 18, 1964

Before Vogel, Matthes and Blackmun, Circuit Judges.

MATTHES, Circuit Judge.

This is an action for infringement of Patent No. 2,627,798 (hereinafter sometimes referred to as "Patent No. 798") issued to William T. Graham (plaintiff-appellee) on February 10, 1953, for a "Clamp for Vibrating Shank Plows." Graham Plow, Inc. (plaintiff-appellee) is a licensee under the patent. The trial court found the patent valid and that Claims 1 and 2 of the patent were infringed by defendants John Deere Company of Kansas City and Deere & Com-
[fol. 924] pany. From the judgment entered pursuant to findings of fact and conclusions of law defendants (hereinafter called "appellants") have appealed.

Jurisdiction is established by virtue of 35 U.S.C. § 281 and 28 U.S.C. § 1338.

Appellants advance two basic contentions. (1) That Patent No. 798 is invalid for want of invention and that the finding for appellees on this issue is clearly erroneous because the trial court: (a) failed to give proper consideration and effect to the rule that the presumption of

validity is weakened when pertinent prior art was not considered by the Patent Office; (b) applied an improper test of invention. (2) That even if validity of the patent is sustained, appellants' accused devices do not, within the rule or doctrine of equivalents, infringe Patent No. 798.[1] If appellants' position as to contention (1) is sound, i.e., if the Graham patent is invalid for want of invention, there can be no infringement of its claims and we need not consider contention (2). *Selmix Dispensers, Inc.* v. *Multiplex Faucet Co. (Inc.)*, 8 Cir., 277 F.2d 884, 886 (1960); *Caldwell* v. *Kirk Manufacturing Company*, 8 Cir., 269 F.2d 506, 507 (1959), cert. denied, 361 U.S. 915 (1959); *Briggs & Stratton Corporation* v. *Clinton Machine Co.*, 8 Cir., 247 F.2d 397, 400, 401 (1957), cert. denied, 355 U.S. 914 (1958).

Appellees urge and rely upon the uncontroverted rule, established by statute and consistently recognized by the courts, that a patent shall be presumed valid and that the burden of establishing invalidity of a patent shall rest on the party asserting it. 35 U. S. C. § 282; e.g., *Radio Corpo-*
[fol. 925] *ration of America* v. *Radio Engineering Laboratories, Inc.*, 293 U.S. 1, 7-8 (1934); *Steffan* v. *Weber Heating and Sheet Metal Company*, 8 Cir., 237 F.2d 601, 602 (1956). It is equally clear, however, that the presumption of validity is a rebuttable one, that when substantial evidence attacking the validity of a patent is introduced, the question whether the patent constitutes an invention is for the court, *Steffan* v. *Weber Heating and Sheet Metal Company*, supra, 237 F.2d at 602; *Continental Farm Equipment Co.* v. *Love Tractor*, 8 Cir., 199 F.2d 202, 204 (1952), cert. denied, 345 U.S. 909 (1953), and that the presumption of validity is weakened if applicable prior art is not considered by the Patent Office. *L. S. Donaldson Company* v. *La Maur, Inc.*, 8 Cir., 299 F.2d 412, 420 (1962), cert. denied, 371 U.S. 815 (1962); *Day-Bright Lighting, Inc.* v. *Sandee Manufacturing Co.*, 7 Cir., 286 F.2d 596, 597 (1960), cert.

[1] For a comprehensive and enlightening discussion of the doctrine of equivalents, see *Parmelee Pharmaceutical Company* v. *Zink*, 8 Cir., 285 F.2d 465, 470, et seq. (1961).

denied, 366 U.S. 963 (1961); *Cornell* v. *Adams Engineering Company,* 5 Cir., 258 F.2d 874, 875 (1958).

If, as urged by appellants, the trial court failed to apply the proper legal test or standard, it necessarily follows that its finding of patentability was induced by an erroneous view of the law, its finding is clearly erroneous, and the judgment based upon such finding cannot stand. *Great A. & P. Tea Co.* v. *Supermarket Equipment Corporation,* 340 U.S. 147, 153-154 (1950); *Selmix Dispensers, Inc.* v. *Multiplex Faucet Co. (Inc.),* supra, 277 F.2d at 886; *Caldwell* v. *Kirk Manufacturing Company,* supra, 269 F.2d at 508, 509.

This court has adhered to the position that since *Cuno Engineering Corp.* v. *Automatic Devices Corp.,* 314 U.S. 84 (1941), "the amount of originality and ingenuity, over and beyond novelty and utility, which will constitute in-[fol. 926] vention necessary to sustain a patent for a combination of old elements [such as we have here] in a crowded art, has increased." *Briggs & Stratton Corporation* v. *Clinton Machine Co.,* supra, (concurring opinion of Judge Sanborn, 247 F.2d at 401) and cases there cited. In *Caldwell* v. *Kirk Manufacturing Company,* supra, 269 F.2d at 509, Judge Sanborn again expressed the principle in this language:

> "More exacting standards for determining patentable invention have been applied by the courts in recent years than was formerly the case. In *Trico Products Corporation* v. *Delmar Corporation,* 8 Cir., 180 F.2d 529, 533, this Court said:
>
> "* * * 'The Supreme Court has, we think, raised the standards of originality necessary to sustain patents for improvements such as those involved in the instant cases, regardless of their usefulness or commercial success. Compare, *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.,* 261 U.S. 45, 43 S.Ct. 322, 67 L.Ed. 523, and *Temco Electric Motor Company* v. *Apco Manufacturing Company,* 275 U.S. 319, 48 S.Ct.

170, 72 L.Ed. 298, with *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, supra, 314 U.S. 84, 62 S.Ct. 37, 86 L.Ed. 58.'"

The same pronouncement appears in *Steffan* v. *Weber Heating and Sheet Metal Company*, supra, 237 F.2d at 604; *Selmix Dispensers, Inc.* v. *Multiplex Faucet Co. (Inc.)*, supra, 277 F.2d at 887; and *Crome & Company* v. *The Vendo Company*, 8 Cir., 299 F.2d 852 (1962), where Judge Blackmun in his dissent observed, "Mechanical combination patents in this court have met with little recent success."

With these pronouncements clearly in mind, we turn to the factual setting of the case. Inasmuch as the trial [fol. 927] court's Memorandum Opinion, Findings of Fact, and Conclusions of Law, W.D. Mo., 216 F.Supp. 272 (1963), adequately embody the general factual background, including the terms of the patent claims and other technical descriptions, we need here set forth only a condensed version of the facts.

Appellee Graham originally submitted twelve claims in his application to the Patent Office for a patent on a device which eventually was issued as Patent No. 798. The Patent Office rejected all twelve claims, partially on the grounds that some of them failed to patently distinguish from a prior patent issued to Graham—No. 2,493,811 (Patent No. 811)—and partially on the grounds of lack of invention. Graham then submitted two claims to be substituted for the original twelve, and these two claims were the basis for issuance of the 798 Patent.

Broadly stated, Patent 798 relates to the mounting of tools on a frame which is moved over the ground to break the soil—a process termed "chisel plowing." Appellee Graham Plow, Inc.'s predecessor manufactured and sold chisel plows wherein the upper forward portion of the shank was rigidly fixed to the plow beam by a *rigid* clamp. Because these rigid structures proved to be unsatisfactory due to their inability to withstand shocks when used for plowing in rocky country, Graham devised a *spring* clamp

structure, and was issued a patent—No. 811—on it in January, 1950. Graham Plow, Inc. has continued to manufacture and sell plows with spring clamps which embody the principle of the 811 Patent, but neither appellees, nor any licensee under them, has ever manufactured or sold a clamp embodying the 798 structure.

The 798 clamp—also a "spring clamp"—is used to connect the upper forward end of a resilient shank to a beam [fol. 928] with the lower end of the shank carrying a chisel for plowing or other ground-working operations. The clamp includes a body portion movably attached to the beam with a rearward portion having a pivot pin on which is pivotally mounted a movable part with a plate portion extending forwardly or longitudinally of the normal direction of travel of the plow. The upper forward portion of the shank extends through a stirrup or loop element at the rear of the movable part and longitudinally *beneath* the plate portion of the movable part and is connected to the plate at the forward end thereof at a substantial distance from the pivot pin, whereby the shank and movable part pivot together about the axis of the pivot pin. A coil spring is arranged at the forward end of the body and, through a nut, washer and spring rod, acts on the shank and plate member to resiliently urge the forward end of the shank and plate upwardly toward the body of the clamp to a stop engagement therewith to normally hold the shank in normal position. In plowing operations, forces are exerted rearwardly and upwardly on the chisel or other ground-working tool, and when sufficient to overcome the forces applied by the spring the shank and movable part will pivot on the pivot pin with the forward end of the shank and plate moving downwardly against the tension of the spring. Forces in plowing hold the shank against the rear of the plate of the movable part and when said forces are removed or lessened, or the ground-working tool removed from the ground, the shank at the rear of the movable part is supported by a stirrup or loop that embraces the shank adjacent the pivot of the movable part. In plowing operations, if the ground-working tool

strikes a rock or other obstruction, substantial shock and forces are applied to the shank, pivoting the shank and movable member about the pivot pin, tending to compress [fol. 929] the spring and permitting upward movement of the ground-working tool whereby it can pass over the rock or obstruction and, as it passes over such obstruction, the stirrup or loop on the movable part supports the shank against excessive rebound.

Five prior patents indicating the state of the prior art were made of record in the Patent Office during Graham's prosecution of the application for the 798 Patent. Four of these patents, ten others not of record in the Patent Office, and two other prior spring clamp devices not of record in the 798 file wrapper, were relied upon below by appellants as revealing the prior art.

Since our disposition of this case, as subsequently revealed, does not necessitate resolution of the infringement issue, we forego discussion of appellants' two accused devices, found to infringe Patent 798.

The following summarized findings of the trial court on the validity issue, among other findings and conclusions, induced the ultimate decision in favor of appellees:

(1) Although not all the now disclosed prior art was cited by the Patent Office, the statutory presumption of validity of the 798 Patent is not weakened or destroyed since the uncited prior art is "similar to some of the patents relied upon by the Patent Office Examiner."

(2) The prior art as a whole in one form or another contains all of the mechanical elements of the 798 Patent, and in a broad sense all of the elements are found in the Glencoe clamp. [Glencoe was not cited by the Patent Office]. Nevertheless, the particular arrangement of the elements disclosed by 798 is not present in any single reference or as a whole.

[fol. 930] (3) An *improved* functional result is obtained by the 798 Patent, and the main improvement is due to the particular arrangement of the shank in relation to the pivoted member and spring member which reflects in down-

ward flexing of the shank at the forward portion thereof alongside the plate portion of the pivoted member and does lessen wear and tear to some parts of the clamp.

(4) The 798 Patent is an improvement patent and, while the individual mechanical elements may be found in the prior art, taken as a whole the 798 structure is sufficiently different in the operative relationship of the shank and pivoted member with a slight but significant difference in the flexing of the forward portion of the shank that is not found in the prior art, so that the 798 structure involves invention.

(5) The differences between the 798 Patent and the prior art are such that the 798 combination would not have been obvious at the time Graham made his invention to a person having ordinary skill in the art of agricultural implements and other related arts.

We approach determination of the validity issue fully cognizant that the mere fact that all of the elements embodied in the 798 structure are found in the prior art does not ipso facto mean that the combined structure is not patentable. *Continental Farm Equipment Co.* v. *Love Tractor,* supra, 199 F.2d at 205. However, we also announced in *Continental,* supra, 199 F.2d at 204, citing *Great A. & P. Tea Co.* v. *Supermarket Equipment Corp.,* supra, 340 U.S. at 152, that when combination patent claims are under examination, courts should scrutinize them with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. To be [fol. 931] patentable, a combination of individually old elements must contribute something new; the elements must cooperate to produce an accumulation which exceeds the sum of its parts. E.g., *Great A. & P. Tea Co.* v. *Supermarket Equipment Corp.,* supra, 340 U.S. at 151-152; *Lincoln Engineering Co.* v. *Stewart-Warner Corp.,* 303 U.S. 545, 549 (1938); *John Blue Company* v. *Dempster Mill Mfg. Co.,* 8 Cir., 275 F.2d 668, 672-673 (1960); *Caldwell* v. *Kirk Manufacturing Company,* supra, 269 F.2d at 508. Compare also, *Powder Power Tool Corp.* v. *Powder Actu-*

ated Tool Co., 7 Cir., 230 F.2d 409, 415-416 (1956). Stated differently, "The bringing together of old elements in a mechanism involving no new principle, to produce an old result, however skillfully done, even though the result marks an advance in efficiency and utility, is but an exercise of mechanical skill and not invention." *General Bronze Corp.* v. *Cupples Products Corp.*, 8 Cir., 189 F.2d 154, 161 (1951).

Our task is to first ascertain whether the trial court applied the proper legal standard in determining the validity of Patent 798, and then to decide whether the patent satisfies the requirements of this test. At this point, we note that the 798 Patent has been held valid on two occasions in appeals before the Fifth Circuit. *Jeoffroy Mfg., Inc.* v. *Graham*, 219 F.2d 511 (1955), cert. denied, 350 U.S. 826 (1955), and *Graham* v. *Cockshutt Farm Equipment, Inc.*, 256 F.2d 358 (1958). Unlike our court, the Fifth Circuit has "long recognized . . . that an improvement combination is patentable even though its constituent elements are singly revealed by the prior art, where . . . it produces an *old result in a cheaper and otherwise more advantageous way.*" (Emphasis supplied.) 219 F.2d at 519. For other recognition by the Fifth Circuit of the "old result in a more efficient and economical way" see, *Cornell* v. *Adams Engineering Company*, supra, 258 F.2d at 875-876.

[fol. 932] Undoubtedly, and perhaps understandably, the trial court below was at least partially motivated in its decision by the two prior Fifth Circuit cases involving Patent 798. Of course, the decisions of another circuit are entitled to respect and are not to be brushed aside lightly, but they are not binding upon appellants in this case, nor upon us. See *Aeration Processes* v. *Lange*, 8 Cir., 196 F.2d 981, 982 (1952), cert. denied, 344 U.S. 834 (1952). It is for this court, upon the record here, including the arguments, stipulations, and concessions, to decide whether Patent 798 is valid.

Here, the trial court couched its Finding XV rather precisely in the statutory standard of invention found in

35 U.S.C. § 103, and found that the 798 Patent structure would not have been obvious at the time it was made to a person having ordinary skill in the art. But, other findings of the court lay stress on "an *improved* functional result," and nowhere does the court find any new or significantly different result. Seemingly, the trial court failed to apply the more exacting standard which in our view is implicit in the teachings of the Supreme Court in *Cuno Engineering Corporation,* supra, 314 U.S. 84, and *Great A. & P. Tea Co.,* supra, 340 U.S. 147, and which we have applied in numerous cases subsequent thereto.

Furthermore, even assuming that the trial court's finding of "a slight but significant difference in the flexing of the forward portion of the shank that is not found in the prior art" can be construed as a finding of a new result, the court's further finding that Patent 798 exhibits invention and would not have been obvious to a person having ordinary skill in the art is clearly erroneous. The alleged patentable difference between the 798 structure and the prior art lies in the arrangement in the 798 structure of [fol. 933] the shank *below* the plate of the pivoted member, permitting the shank to flex throughout its length and particularly permitting the forward portion of the shank to flex downwardly *away* from the plate. Theoretically, at least, when the plate is below the shank, as in the prior art, there is a tendency of the shank to bend *against* the plate and when the plate is above, as in the 798 Patent, there is a tendency of the shank to bend *away from* the plate.

But is this difference significant enough to support the patent? We think not. Painstaking examination of the entire record, including the testimony of the experts, convinces us that the changes in the prior art embodied in the 798 Patent involve only application of mechanical ability, and that there is no adequate evidentiary support for the trial court's finding of invention. As surely as the disc harrow device in *Continental Farm Equipment Co.* v. *Love Tractor,* supra, 199 F.2d 202, and the animal rubbing and oiling apparatus in *Caldwell* v. *Kirk Manufacturing Company,* supra, 269 F.2d 506—to name but two, did not in-

volve inventive genius, neither does the rearrangement of shank, plate and pivot pin in the 798 structure. While perhaps more efficient, the inversion of the parts so as to allow the shank to flex downwardly away from the plate above it did not bring about a significantly new or different result, and would have been obvious to a person having ordinary skill in the art.

Additionally, it is significant that in the 798 Patent claims, nothing is mentioned about the shank reflex which became the basic reason for sustaining the validity of the patent in the trial court. To be sure, it is the claim that measures the grant to the patentee, *Briggs & Stratton Corporation* v. *Clinton Machine Co.*, supra, 247 F.2d at 400, and here the claims of the 798 Patent are silent concerning [fol. 934] the alleged flex.[2] Appellants point out that, to the contrary, any flexing of the [illegible] way from the plate portion of the pivoted mem[illegible] in direct conflict with the claims which s[illegible] eans connecting the shank to the plate mainta[illegible] face of the shank in *constant continuous* conta[illegible] he underface of said plate portion of the shank attaching member." (Emphasis supplied.)[3] See entire claims set forth, supra, 216 F.Supp. at 274-275.

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[2] In *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, supra, 303 U.S. at 550, the Supreme Court, in refusing to accept a suggestion that a function, not mentioned in the specifications of the patent, was significantly new and different so as to support the validity of the patent, stated:

> "The suggestion seems to be an afterthought. No such function . . . is hinted at in the specifications of the patent. If this were so vital an element in the functioning of the apparatus it is strange that all mention of it was omitted."

[3] Appellees take issue with this assertion, stating that appellants "are interpreting the wording of the claims to specify that the contact between the upper face of the shank and the under face of the plate portion is for the entire length of those faces, but the claims do not say that. *There is no extent of such contact specified in the claims.* Actually in the structure the bolt and nut at the forward end of the plate and shank maintain the upper face of the shank in constant continuous contact with the under face of

It is also interesting to note that in the early stages of this case appellees propounded three interrogatories under Rule 33, Fed. R. Civ. P., inquiring as to flex in the shank of appellants' accused devices. Appellants objected on the grounds that the interrogatories were not relevant, and Judge Ridge—then sitting on the case—sustained the objections, stating:

> "These interrogatories relate to a flexing of the shank of the accused device, and appear irrelevant since such a flexing is not a claim of the patent in suit and Plaintiffs do not undertake to otherwise demonstrate the relevancy of such inquiry."

[fol. 935] In conclusion, we observe once again that the Constitution, Article I, Section 8, Clause 8, authorizes Congress to reward inventive genius but not mechanical skill alone. *Cuno Engineering Corporation* v. *Automatic Devices Corporation,* supra, 314 U.S. at 91; *Steffan* v. *Weber Heating and Sheet Metal Company,* supra, 237 F.2d at 604. The public is a silent but an important and interested party in all patent litigation, and is entitled to protection against the monopolization of what is not lawfully patentable. *Rota-Carb Corporation* v. *Frye Manufacturing Company,* 8 Cir., 313 F.2d 443, 444 (1963). For a recent discussion of the purpose of federal patent law and the need to guard the rights of the public, see *Sears, Roebuck & Co.* v. *Stiffel Co.,* 376 U.S. 225, 228-231 (1964).

Since we have concluded that the 798 Patent is invalid, there is obviously no need to consider the infringement issue.

Accordingly, and for the reasons stated in the opinion, the judgment is reversed and the case remanded with directions to dismiss the action.

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the plate portion of the shank-attaching member at that part where the bolt and nut pass through. . . . The flexing is in that portion of the shank that is rearwardly of that bolt. . . ." (Emphasis supplied.)

[fol. 936]

IN THE UNITED STATES COURT OF APPEALS

FOR THE EIGHTH CIRCUIT

No. 17,441

JOHN DEERE COMPANY OF KANSAS CITY, a Corporation, and DEERE & COMPANY, a Corporation, Appellants,

vs.

WILLIAM T. GRAHAM, and GRAHAM PLOW, INC.

Appeal from the United States District Court for the Western District of Missouri.

JUDGMENT—June 18, 1964

This cause came on to be heard on the record from the United States District Court for the Western District of Missouri, and was argued by counsel.

On Consideration Whereof, It is now here Ordered and Adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, reversed with costs; and that John Deere Company of Kansas City, a Corporation, and Deere & Company, a Corporation, have and recover against William T. Graham, and Graham Plow, Inc., the sum of Four Thousand Two Hundred Twenty-two and 32/100 Dollars for their costs in this behalf expended and have execution therefor.

And it is further Ordered by this Court that this cause be, and it is hereby, remanded to the said District Court with directions to dismiss the action.

[fol. 937]

(Petition of Appellees for Rehearing)

(Filed in U.S. Court of Appeals,
Eighth Circuit, on July 7, 1964)

IN THE UNITED STATES COURT OF APPEALS

FOR THE EIGHTH CIRCUIT

No. 17,441

Civil

JOHN DEERE COMPANY OF KANSAS CITY, a Corporation, and DEERE & COMPANY, a Corporation, Appellants,

vs.

WILLIAM T. GRAHAM, and GRAHAM PLOW, INC., Appellees.

Appeal from the District Court of the United States for the Western District of Missouri, Western Division.

PETITION FOR REHEARING

Appellees (Petitioners here), William T. Graham and Graham Plow, Inc., respectively, petition the Honorable Circuit Judges Vogel, Matthes and Blackmun for a rehearing to correct certain fundamental errors upon which their opinion dated June 18, 1964, is founded.

[fol. 938]

Statement of Errors in the Opinion of June 18, 1964

I.

Presumption of Validity

This Court's opinion, on page 3, cites decisions relative to the presumption of validity and that the presumption of validity is weakened if applicable prior art is not considered by the Patent Office and, on page 7, mentions that

there were ten patents not of record in the Patent Office and two prior spring devices not of record in the 798 file wrapper relied upon by Appellants as revealing the prior art. Apparently, this Court considered that relying on additional patents not cited by the Patent Office weakened the presumption of validity of the 798 patent. The Patent Office had before it a Rolf application for patent on the Glencoe structure and which matured into Patent No. 2,739,518, which application was copending with the application for the Graham 798 patent (R. Vol. III, pp. 593-4); the Examiners in the same Division acted on both the application for the Graham 798 patent and the Rolf application (R. Vol. II, pp. 400-1; Vol. III, pp. 607, 685), and also the Examiners cited the Rix Patent No. 287,965 (Vol. III, pp. 607, 759), all of which indicates that the Examiners did consider some of the alleged additional prior art. Furthermore, the Patent Office cited the Petersen Patent No. 57,391 (R. Vol. III, pp. 727, 733) which was of the same character of some of the alleged additional prior art (R. Vol. II, pp. 432-3), and the Patent Office cited the Graham 811 patent (R. Vol. III, p. 717) and it was substantially the same as the Jeoffroy SC-580 device. The [fol. 939] Court apparently overlooked similarities of the alleged additional prior art to that cited by the Patent Office and, when those similarities are considered, it shows that the Patent Office did consider the applicable prior art and it should be held that the presumption of validity is not weakened.

II.

Legal Standard in Determining Validity

This Court's opinion, page 9, quotes from the decision in *General Bronze Corp.* v. *Cupples Products Corp.*, 8 Cir., 189 F. 2d 154, 161 (1951) in setting out the test of validity and, on page 10, suggests that the Trial Court seemingly failed to apply the more exacting standards that this Court feels are implicit in the teachings of the Supreme Court in certain cases.

The Court of Appeals apparently applies a "more exacting standard" for invention (Op. p. 10) than required by

statute, 35 U.S.C. Sec. 103, when relying on the *Cuno Engineering Corporation* case (314 U.S. 84), which case held invention "must reveal a flash of creative genius". 35 U.S.C. Sec. 103 abrogated such a standard for invention. *Pacific Contact Laboratories, Inc.* v. *Solex Laboratories, Inc.*, 9 Cir., 209 F. 2d 529, 532.

In this case, the Court overlooks the fact that there can be an improved functional result in operative parts with an old end purpose or result, and at the same time a new result in parts of the structure. The old end result is plowing or breaking the soil. The improved functional result is in the use of flexing of the shank to reduce breakage of the equipment. The new result in the 798 patent is the mounting with the shank bending away from the plate instead of against the plate as was the characterization of [fol. 940] the prior art. This Court has failed to consider all of the Trial Court's Finding XIII wherein the new result is embodied in the description of the cause of the improved functional result. When fully considered, the Findings XIII and XV of the Trial Court indicate the proper legal standards of determining validity were applied.

III.

Significance and Obviousness of the Invention

This Court's opinion, on pages 10 and 11, that the difference between the 798 patent and the prior art is not significant enough to support the patent and that the inversion of the parts so as to allow the shank to flex downwardly away from the plate would have been obvious to a person having ordinary skill in the art, overlooked the fact that all of the prior art showed shanks and plates arranged for the shank to bend against the plate. The actual teachings of the prior art from an examination of the charts (Def. Ex. 24 and 25) was that they should be so arranged and was not as Fishleigh, Defendants' expert, applied them with hindsight.

Furthermore, the record shows that Defendants' engineers did not find it obvious. Surveys (Def. Ex. 30 and 31, Vol. IV, pp. 799, 823) were made in the field and the Graham

798 patent was before them when the accused devices were designed. The record is devoid of any prior art that teaches a structure wherein the shank bends away from the plate instead of bending against the plate. The Court overlooks the fact that all of those skilled in the art and working to devise mountings for tools on a frame to break the soil arranged the shank to bend against the plate. Graham was the first to conceive of a structure having a different bending. The fact that this concept escaped all [fol. 941] others working in the field is evidence that the change was not obvious.

IV.

Flexing Not Mentioned in Claims

This Court's opinion (pp. 11-12) attaches great weight to the fact that the shank flex is not mentioned in the claims of the Graham 798 patent and apparently agrees with Appellants' point that any flexing of the shank away from the plate portion of the pivoted member would be in direct conflict with the claims which specify that the means connecting the shank to the plate maintain "the upper face of the shank in constant continuous contact with the underface of said plate portion of the shank attaching member".

This opinion fails to recognize that the flexing is a function of the structure and that it is not necessary for a function to be mentioned in a claim and that at the time of issuance of the 798 patent functional claims were considered improper. *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U.S. 1, 67 S. Ct. 6, 91 L. Ed. 3, 9. Also, the record (Vol. II, pp. 366, 461) shows that the structure did provide for flex of the shank while there was constant continuous contact at the forward end of the shank. The claims do not require any particular extent of such contact.

This Court's reliance on Judge Ridge's ruling on interrogatories ignores the fact the plaintiffs merely preferred to wait until the trial to make the showing of the flexing of the shank and the ruling was not made after such showing.

Wherefore, Appellees respectfully and earnestly pray that the Court will give this petition careful consideration; that rehearing be granted and that upon final hearing the judgment of the Trial Court be affirmed.

[fol. 942] Certificate of Counsel

I, Orville O. Gold, one of the attorneys for Appellees, hereby certify that the foregoing petition for rehearing is presented in good faith in the earnest and sincere belief that this Court has erred in the particulars pointed out, and this petition is not made for delay.

It is further certified that copies of this petition have been served upon the attorneys of record for appellants by delivering same to Scofield, Kokjer, Scofield & Lowe, 1325 Rialto Building, Kansas City, Missouri, this 6th day of July, 1964.

Respectfully submitted,

Orville O. Gold, Attorney for Appellees.

[fol. 943]

In the United States Court of Appeals

For the Eighth Circuit

No. 17,441. September Term, 1963.

John Deere Company of Kansas City, a corporation, and Deere & Company, a corporation, Appellants,

vs.

William T. Graham and Graham Plow, Inc.

Appeal from the United States District Court for the Western District of Missouri.

Order Denying Petition for Rehearing—July 13, 1964

Petition of appellees for rehearing filed in this cause having been considered, It is now here Ordered by this Court that the same be, and it is hereby, denied.

[fol. 944] Clerk's Certificate to foregoing transcript (omitted in printing).

[fol. 945]

SUPREME COURT OF THE UNITED STATES

No. 580, October Term, 1964

WILLIAM T. GRAHAM, et al., Petitioners,

vs.

JOHN DEERE COMPANY OF KANSAS CITY, et al.

ORDER ALLOWING CERTIORARI--January 18, 1965

The petition herein for a writ of certiorari to the United States Court of Appeals for the Eighth Circuit is granted, and the case is placed on the summary calendar.

And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.